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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,096	02/20/2001	Steven M. Maine		4004

7590 04/20/2005  
DAVID JACOBSEN  
P.O. BOX 124  
COUNCIL, ID 83612

EXAMINER

HUSAR, STEPHEN F

ART UNIT PAPER NUMBER

2875

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/788,096	<b>Applicant(s)</b> MAINE, STEVEN M.	
	<b>Examiner</b> Stephen F. Husar	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 4-9 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/05038. RE claim 4, Figs. 2 and 5 show an illuminated tool holder having a light source "34" to illuminate the tips of a plurality of instruments "21" which are pivotally nested in a hand grip "10". RE claim 5, see light switch "31". Re claims 6 and 7, note in Figs. 2 and 5 that grip "10" has multiple tools "21", which pivotally rotate to provide the recited 15 to 60 degrees of positioning. Re claims 8 and 9, note that the grip "10" is sized to ergonomically rest in the left or right hand of the user.

3. Claims 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by CHUNG (6,511,199). RE claim 4, Figs. 2 and 5 show an illuminated tool holder having a light source "34" to illuminate the tips of a plurality of instruments "21" which are pivotally nested in a hand grip "10". RE claim 5, see light switch "31". Re claims 6 and 7, note in Figs. 2 and 5 that grip "10" has multiple tools "21", which pivotally rotate to provide the recited 15 to 60 degrees of positioning. Re claims 8 and 9, note that the grip "10" is sized to ergonomically rest in the left or right hand of the user.

### ***Response to Arguments***

4. Applicant's arguments filed 1/12/04 have been fully considered but they are not persuasive. Applicant's argument that the CHUNG references do not anticipate the claimed invention are not persuasive. For example, claim 4 merely recites a light source to illuminate the tip of an instrument and a handheld grip to accept a variety of instruments. As clearly shown for example in Fig. 2 of Chung (6511199), there is a light source "34" for illuminating the tip of the instrument and a handle holding a variety of those instruments "20". Further applicant's argument that Chung only provides illumination along the same axis of the tool and therefore is unable to provide illumination at the tool tip is not understood. Chung illumination source "34" is offset from the main central axis of the tool and therefore it is physically impossible given the light source's location to provide illumination along the same axis as the tool. Further, Chung clearly discloses in the "Summary of the Invention" in col. 1, lines 47-51, that the "... hand tools which includes lighting equipment for lighting the area at the working end of the tool..." . The working end of the tool is the tip of most tools and therefore

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illuminating the working end of the tool illuminates the tip of the tool. Finally, Chung 's multi-position docking system as best shown in Fig.5 provides at least a 15-60 degree positioning of his multiple instruments to the longitudinal axis of the illumination source as set forth in applicant's claim 7. It appears that applicant is arguing that the angle of intersection between the longitudinal axis of the illumination source and the longitudinal axis of the instrument is an acute angle between 15-60 degrees but never actually reciting or claiming that limitation. Applicant is asked to study the reference to Chung (6511199) for the necessary detailed claim structure to positively and clearly recite the limitations, which constitute his invention. It is for the reasons set forth above that applicant's arguments that appear to be mainly drawn to details of the invention, which are shown but never claimed, are considered non-persuasive.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

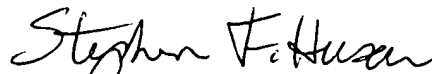
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Husar whose telephone number is 703-308-1932. The examiner can normally be reached on Monday-Friday from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

  
Stephen F. Husar  
Primary Examiner  
Art Unit 2875

SFH